



Patent
Attorney's Docket No. 032326-057

#10

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)
Stephane AYALA et al.) Group Art Unit: 3729
Application No.: 09/545,288)
Filed: April 7, 2000)
For: METHOD FOR MAKING SMART)
CARDS CAPABLE OF OPERATING)
WITH AND WITHOUT CONTACT)

RECEIVED

OCT 25 2004

OFFICE OF PETITIONS

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the Office Communication dated October 1, 2001, Applicants respectfully request reconsideration and withdrawal of the restriction requirement, on the grounds that it is incomplete and/or improper.

The basic requirement for a proper restriction between inventions is that the inventions must be independent or distinct as claimed. 35 U.S.C. § 121; MPEP § 803. The initial burden is on the Examiner to meet this requirement. Specifically, MPEP § 816 states:

The particular reasons relied upon by the Examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate.

In the present case, the Office Communication does not even set forth a conclusion, let alone any reasons that would support the restriction requirement. Since there has been no effort to show independence or distinctness between claimed inventions, the Office

11-27-01 CRS

Communication fails to meet both the standards set forth by the Patent and Trademark Office and the requirements of the statute, and therefore should be withdrawn as improper.

In addition, the MPEP sets forth a second criterion for a proper restriction requirement, namely that there must be a serious burden on the Examiner. For purposes of this criterion, the Manual states that a *prima facie* case may be made "if the Examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search..." Again, the Office Communication contains no such showing, and therefore fails to meet the second criterion for a proper restriction requirement. For this additional reason, therefore, the requirement should be withdrawn.

Although the restriction requirement is being traversed for the reasons set forth above, in order that this response be considered to be complete, the following provisional elections are being made:

GROUP I:

Applicants provisionally elect the species of Figures 1 and 3. The claims readable upon this species include claims 1, 2 and 4-30, with claims 1, 4-23 and 25-30 being generic to both species of this group.

GROUP II:

Applicants provisionally elect the species of Figures 5A-5C. The claims readable upon this species include claims 1-4, 6-24, 27 and 29, with claims 1-3, 6-23, 27 and 29 being generic to both of the species in this group.

1, 2 6-24, 27, 29

GROUP III:

Applicants provisionally elect Species 3A. The claims readable upon this species include claims 1-16 and 19-30, with claims 1-14 and 21-30 being generic to both species of this group.

GROUP IV:

Applicants provisionally elect Species 4D. The claims readable upon this species include claims 1-13, 23-25 and 30, with claims 1-13, 24 and 25 being generic to more than one of the species in this group.

Reconsideration and withdrawal of the restriction requirement is respectfully requested, on the grounds that it does not meet either of the two established criteria for insisting upon restriction. In the event that the requirement is repeated, or a new one is instituted, it is respectfully requested that the Examiner comply with the standards set forth in the MPEP, and explain the reasons for requiring the restriction.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

By: James A. LaBarre

James A. LaBarre
Registration No. 28,632

Date: November 27, 2001

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620